

REMARKS

I. Introduction

With the addition of new claims 22 and 23, claims 1 to 3, 9, and 11 to 23 are pending and being considered. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1 to 3, 9, and 11 to 21 Under 35 U.S.C. § 112, First Paragraph

Claims 1 to 3, 9, and 11 to 21 were rejected under 35 U.S.C. § 112, first paragraph, as to the written description requirement.

Claims 1, 20, and 21 have been rewritten to replace the feature of “triangular indentations” with the feature of --tapered indentations--, thereby obviating the present rejection. Support for the amendments to claims 1, 20, and 21 may be found in the Specification, e.g., at ¶ 41; and Figures 1B, 1D, 2B, 2C, 3, and 4.

Accordingly, it is respectfully submitted that claim 1, as presented, is allowable, as are its dependent claims 2, 3, 9, and 11 to 21.

It is therefore respectfully requested that the rejection be withdrawn.

III. Rejection of Claims 1 to 3, 9, and 11 to 21 Under 35 U.S.C. § 103(a)

Claims 1 to 3, 9, and 11 to 21 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 7,121,061 (“Jazzar”) and U.S. Patent No. 5,671,582 (“Reay”). It is respectfully submitted that the combination of Jazzar and Reay does not render unpatentable the presently pending claims for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007).

Claim 1, as presented, relates to a modular building system, comprising (a) *multiple portable pre-cast modules*, wherein each of the multiple modules include (i) structural steel mesh; (ii) cementitious mortar encasing the structural steel mesh; and (iii) *tapered indentations located along edges of the module and exposing portions of the structural steel mesh*; (b) metal plate connectors; and (c) *welds between the metal plate connectors and the exposed portions of the structural steel mesh thereby connecting adjacent modules*, in which *the tapered indentations located along edges of the adjacent modules are aligned with each other, the metal plate connectors and the welds are situated in the aligned tapered indentations of the adjacent modules, and the adjacent modules form a wall*. Support for the amendments may be found in the Specification, e.g., at ¶¶ 41 and 45; and Figures 3 and 4.

The combination of Jazzar and Reay does not disclose, or even suggest, the features of **multiple portable pre-cast modules**, in which **adjacent modules form a wall**. Instead, Jazzar merely indicates “a **monolithic** reinforced concrete portion of a building ... having a horizontal width substantially equal to the wall length” and extending from floor to ceiling. (Jazzar, col. 2, lines 25 to 31 (emphasis added)). In addition, the monolithic concrete portion of Jazzar has “horizontal extents substantially equal to the selected room size.” (Jazzar, Abstract). Further, Jazzar explicitly states that “the joints [of Jazzar] between various concrete members are all in the floors and ceilings of finished rooms.” (Jazzar, col. 7, lines 45 to 47). Thus, the monolithic concrete portion of Jazzar is plainly not the same as a portable pre-cast module, in which adjacent modules form a wall, and in fact, Jazzar explicitly teaches away from the feature of *multiple portable pre-cast modules*. In addition, Reay merely indicates side slab walls 3 that span at least **one storey**, since the side slab walls 3 include at least one cavity 6 to attach a floor slab 2. (Reay, col. 1, lines 45 to 65). Thus, nowhere does Reay disclose multiple portable pre-cast modules, in which adjacent modules form a wall.

Accordingly, the combination of Jazzar and Reay does not disclose, or even suggest, the features of **multiple portable pre-cast modules**, in which **adjacent modules form a wall**, as provided for in the context of claim 1, as presented.

In addition, the combination of Jazzar and Reay does not disclose, or even suggest, the feature of **tapered indentations located along edges of the**

module and exposing portions of the structural steel mesh. Instead, although Jazzar indicates a slab 42 having notches, the ends of reinforcing members are **not exposed** by the notches but situated between the notches. (Jazzar, col. 6, lines 35 to 38). Indeed, the Final Office Action at page 3 admits that “Jazzar does not expressly disclose indentations ... exposing portions of said structural steel mesh.” Further, nowhere does Jazzar indicate that its notches are **tapered**. In addition, Reay merely indicates cavities 6 on an **inner surface 7** of the wall 3. (Reay, col. 2, lines 43 to 45). Further, nowhere does Reay indicate that its cavities are **tapered**. Thus, nowhere does Reay disclose tapered indentations located along edges of the module.

Accordingly, the combination of Jazzar and Reay does not disclose, or even suggest, the feature of **tapered indentations located along edges of the module and exposing portions of the structural steel mesh**, as provided for in the context of claim 1, as presented.

Further, the combination of Jazzar and Reay does not disclose, or even suggest, the feature of **welds between the metal plate connectors and the exposed portions of the structural steel mesh thereby connecting adjacent modules**. Jazzar merely indicates **unset concrete** to connect wall members, and the unset concrete may simply surround exposed reinforcing bars. (*See e.g.* Jazzar, col. 6, lines 40 to 48). Nowhere does Jazzar disclose metal plate connectors distinct from its reinforcing bars, i.e., structural steel mesh, or welds between metal plate connectors and exposed portions of structural steel mesh. In addition, Reay merely indicates four different **tie bars** connected by pins 11, washers, nuts, or inter-engagement with the shaped steel bar 8. (Reay, col. 2, line 63 to col. 3, line 35). Thus, nowhere does Reay disclose welds between the metal plate connectors and the exposed portions of the structural steel mesh.

Accordingly, the combination of Jazzar and Reay does not disclose, or even suggest, the feature of **welds between the metal plate connectors and the exposed portions of the structural steel mesh thereby connecting adjacent modules**, as provided for in the context of claim 1, as presented.

Moreover, the combination of Jazzar and Reay does not disclose, or even suggest, the features that **the tapered indentations located along edges of the adjacent modules are aligned with each other** and **the metal plate connectors and the welds are situated in the aligned tapered indentations of**

the adjacent modules, as provided for in the context of claim 1, as presented. Instead, Jazzar merely indicates a slab 42 having grooves or notches, into which reinforcing bars from a wall member project. (Jazzar, col. 6, lines 31 to 35). Thus, in Jazzar, a wall member's **reinforcing bars project into grooves** of a slab 42. Nowhere does Jazzar disclose tapered indentations of a module aligned with tapered indentations of adjacent modules, in which metal plate connectors and welds are situated. In addition, Reay merely indicates **inserting a tie 20 into a cavity 6**, and then **pouring an infill 5** to secure the tie 20 to the floor slab 4. (Reay, col.3, lines 42 to 51). Thus, each cavity 6 of Reay is adjacent only a tie 20 and infill 5. Nowhere does Reay disclose tapered indentations of one module aligned with tapered indentations of adjacent modules, in which metal plate connectors and welds are situated.

Accordingly, the combination of Jazzar and Reay does not disclose, or even suggest, the features that **the tapered indentations located along edges of the adjacent modules are aligned with each other** and **the metal plate connectors and the welds are situated in the aligned tapered indentations of the adjacent modules**, as provided for in the context of claim 1, as presented.

Accordingly, it is respectfully submitted that the combination of Jazzar and Reay does not disclose, or even suggest, all of the features included in claim 1, as presented. Therefore, it is respectfully submitted that the combination of Jazzar and Reay does not render unpatentable claim 1 for at least the foregoing reasons.

Thus, as for claims 2, 3, 9, and 11 to 21 which depend from claim 1 and therefore include all of the features included in claim 1, it is respectfully submitted that the combination of Jazzar and Reay does not render unpatentable these dependent claims for at least the reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

IV. New Claims 22 and 23

New claims 22 and 23 have been added herein. It is respectfully submitted that claims 22 and 23 add no new matter and are fully supported by the present application, including the Specification, e.g., at ¶¶ 20, 33, 41, 44, and 45; and Figures 1A, 1D, 2A, 2C, 3, and 4.

It is respectfully submitted that claims 22 and 23, which ultimately depend from claim 1, are patentable over the references relied upon for at least the reason that the references relied upon do not disclose, or even suggest, all of the features included in claim 1.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date: September 3, 2009

By: /Clifford A. Ulrich/
Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646